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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of

Kazuhiro Kudoh

Serial No.: 09/871,960

Group Art Unit: 2645

Filed: June 4, 2001

Examiner: Gerald Gauthier

For: MOBILE COMMUNICATIONS TERMINAL DEVICE AND METHOD FOR
IDENTIFYING INCOMING CALL FOR USE WITH THE SAME

Honorable Commissioner of Patents
Alexandria, VA 22313 - 1450

**PETITION UNDER 37 C.F.R. § 1.181 THAT A COMPLETE RESPONSE BE
PROVIDED IN ACCORDANCE WITH M.P.E.P. § 707.07(f)**

Sir:

Applicant respectfully petitions under 37 C.F.R. § 1.181 that the USPTO provide a complete response, in accordance with M.P.E.P. § 707.07(f), to Applicant's response dated November 18, 2005, in the above-identified Application.

Applicant respectfully submits that the Examiner has failed to comply with the clear requirements that are set forth in the Manual of Patent Examining Procedure. In particular, the Examiner has failed to comply with the requirements of the M.P.E.P. as set forth in § 707.07(f) by failing to answer all material traversed.

"Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." (M.P.E.P. § 707.07(f), emphasis added).

Simply repeating the text of a previous rejection does not address the traversals provided by the Applicant which clearly contradicts the allegation that those of ordinary skill in the art would have been motivated to combine the references as alleged by the Examiner at the time the invention was made.

Indeed, the Examiner has not addressed the Applicant's very clear traversals and Applicant respectfully submits that the Examiner fails to further prosecution of this application by merely repeating the exact same allegations without addressing the shortcomings and traversals which the Applicant has argued.

Specifically, in the Amendment that was filed on November 18, 2005, the Applicant very clearly pointed out that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner.

The Examiner continues to allege that it would have been obvious to modify the automatic answering system that is disclosed by the Brennan reference to "allow the user to recognize whom is calling before the phone goes off-hook."

However, contrary to the Examiner's allegation, one of ordinary skill in the art would not have been motivated to modify the Brennan reference to "allow the user to recognize whom is calling before the phone goes off-hook" because the answering system that is disclosed by the Brennan reference already allows "the user to recognize whom is calling before the phone goes off-hook."

As is clearly illustrated by the flowchart of Figure 2 of the Brennan reference, the announcement which allows "the user to recognize whom is calling" is performed in step 67, where the handsfree speaker announces the name, then in step 69 the answering system determines if the announcement is complete and, only when the announcement is complete, "the phone goes off-hook." (Col. 3, lines 27-47).

Indeed, the Brennan reference specifically states that "a user will first hear the name of a caller announced and the call will then be connected." (Col. 3, lines 47-50).

Therefore, since the Brennan reference already allows "the user to recognize whom is

calling before the phone goes off-hook,” clearly, there is no motivation to modify the Brennan reference in order to “allow the user to recognize whom is calling before the phone goes off-hook,” as alleged by the Examiner.

The Examiner continues to ignore this traversal.

Additionally, the Examiner admits that the Brennan reference does not teach or suggest outputting the voice information in response to an instruction received from a user.

The Examiner then attempts to remedy the deficiencies of the Brennan reference by referring to the Henderson reference which appears to disclose outputting caller identification data as voice data in response to a user input.

However, contrary to the Examiner’s allegation, one of ordinary skill in the art would not have modified the system that is disclosed by the Brennan reference because such a modification would destroy the intended purpose of the system that is disclosed by the Brennan reference.

Indeed, as explained previously, the Brennan reference very clearly teaches away from making any such modification.

In stark contrast, the Brennan reference discloses an automatic answer feature for a telephone that automatically outputs a name from a speech synthesizer without requiring any instruction at all from a user during the incoming call.

In particular, the Brennan reference explains that “Upon completion of a predetermined number of ring cycles (usually only one) . . . the main controller 34 compares the decoded telephone number (or, if no telephone number, the decoded name) to the telephone numbers (or names) previously entered into the telephone directory 48 (step 64). If there is a match . . . the name in the matching record is read from the telephone directory 84

. . . [and] the main controller 34 forwards the read name to the speech synthesizer 80 (step 65) which translates the read name into a voice announcement signal which is output to the handsfree speaker.” (Col. 3, lines 3 - 31).

Thus, the automatic telephone answering system that is disclosed by the Brennan reference suffers from the same problem that is solved by the present invention.

In other words, the automatic telephone answering system that is disclosed by the Brennan reference automatically outputs the name as a voice announcement to the hands free speaker. Therefore, the voice announcement is heard in the surroundings of the phone without the user of the telephone doing anything.

In stark contrast, the present invention avoids having the voice information automatically being heard in the surroundings by outputting the voice information in response to an instruction from the user during the incoming call.

Therefore, the Brennan reference actively teaches away from the present invention.

M.P.E.P. § 2145 X. D. 2. states:

“It is improper to combine references where the references teach away from their combination.” (Emphasis added).

As explained before, the present invention avoids having the voice information automatically being heard in the surroundings by outputting the voice information in response to an instruction from the user during the incoming call.

In stark contrast, the Brennan reference teaches away from outputting voice information in response to an instruction from the user during the incoming call by providing an automatic telephone answering system which automatically outputs the voice information to the surroundings because the “operation is useful where the user is handicapped, infirm, or

working in a hands-busy situation.” (Col. 3, lines 48-57).

In other words, the Brennan reference teaches that the user is considered to be “handicapped, infirm, or working in a hands-busy situation” and, therefore, unable to provide an instruction when receiving the incoming call in order to output the voice information into the surroundings. Therefore, the Brennan reference teaches that it is not desirable to require any instruction at all from a user before outputting the voice information into the surroundings.

Clearly, one of ordinary skill in the art would not have been motivated to modify the teachings of the Brennan reference to require that a user input be received before outputting voice information when the Brennan reference specifically teaches that it is not desirable to require any instruction at all from a user before outputting the voice information.

The Examiner completely ignores the above traversal regarding the fact that the references teach away from the Examiner’s alleged combination.

One of ordinary skill in the art at the time the invention was made would not have been motivated to combine these references to form the claimed invention.

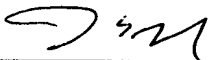
The Examiner’s refusal to address these traversals is clearly contrary to the mandate of the M.P.E.P.

The Examiner’s responses to these traversals are absolutely necessary for prosecution to continue, including an Appeal, and since Applicant requires the Examiner’s responses prior to proceeding to Appeal in order to prepare Applicant’s Brief on Appeal.

For at least the reasons outlined above, Applicant hereby petitions that the USPTO provide a complete response to the Applicant's previous traversals of the rejections of record.

Respectfully Submitted,

Date: 2/9/06


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